

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,997	09/21/2001	William Frederick Mann III	47004.000172	2940

21967 7590 09/22/2005

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,997

Applicant(s)

MANN ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-30 and 39-42 is/are rejected.
- 7) ☒ Claim(s) 15, 16, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3621

DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 10, 14, 16-17, 19-21, 38-39, and 43, are amended.
- No claim has been canceled.
- Claim 44 is added
- Claims 11-44 are considered.

2. Examiner withdraws rejection of claims 14-16 and 38 under 35 U.S.C 112-second paragraphs due to amendments by the applicant.

Claim Objections

3. Claims 15-16 and 43-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

6. Claim 40 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the system for entry of two part personal identification, does not reasonably provide enablement for how the system of claim 40 distinguishes the difference between the first person and the second person and there is no teaching in the specification that would clarify such distinguishing mechanism to differentiation between the two persons as they would enter the "a first partial personal identification entry and a second partial personal

Art Unit: 3621

identification entry". There is no teaching or hint in the specification that would prevent one person to enter the two portions of the personal identification.

7. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make this distinction between the two people as they have been claimed in the claim 40.

8. The claims 41-42 being dependent on the claim 40 are rejected based on the same rationale as above.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 40-42 are rejected under 35 U.S.C. 101 because Claim 1 is a system claim and the claimed invention is directed to non-statutory subject matter. Claims 40-42 are directed to people. Therefore, as the claim includes within its scope a human being it is non-statutory, for the grant of a limited, but exclusive property right in a human being is prohibited by the Constitution.

Response to Arguments

11. Applicant's arguments filed 7 July 2005 have been fully considered but they are not persuasive for the following reasons:

12. In response to applicant argument regarding rejection of Claims 1-12, 18, 31-32 under 35 U.S.C. § 102 as being anticipated by Pare et al.

13. Applicant has amended the claims to replace the word "card controller" with "account controller". However, in the entire remarks section of the correspondent the applicant uses the word "card and at places together with "account card controller". Clarification is required that which word the applicant considers to be the correct one to use in the claims "account controller" or "card controller". It is confusing to respond to the remarks section as they have interchangeably used.

Art Unit: 3621

14. Pare clearly teaches the limitations of the claims as they have been presented in the current of the claims. Applicant has asserted that the Pare reference does not teach a search of a database to find a match for validation of the users. The trust of the applicant's argument is that "If a match is found, the buyer is identified successfully..." The examiner strongly disagrees with the applicant. One skill in the art would understand and know that in order to find a match one has to compare and to compare within many is to find. The Pare reference clearly teaches account controller is tasked with looking up (searching) information of the user in a database (See Pare figure 14-25 and associated text) to validate transaction initiated by such user of the system.

15. Clearly the Pare reference teaches the element of searching a database as it is clearly disclosed in the reference "data is searched in the Data Processing Center DPC" and if the match is successful the users transaction is validated based on user and account identification.

16. Therefore, the examiner maintains the previous rejections of the claimed invention as they have been amended and presented in their current form.

17. The applicant's argument regarding the claims 15-16 and 43-44 have been persuasive and the amendments to claim 38 has put it in condition of allowance.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3621

19. Claims 1-12, 18, 31-32, rejected under 35 U.S.C. 102(e) as being thought by U.S. Patent No. 5,838,812 to David Ferrin Pare et al.

20. As per claim 1, Pare teaches a system for completing a transaction relating to an account in the system wherein an account-holder is not required to know an account number and is not required to have an account card physically present during the transaction, the system comprising:

- a ~~card~~an account controller operating portion including a database, the ~~card~~account controller operating portion linking a selected alias of the account-holder with the account number of the account and a selected personal identification entry, which is associated with the account number, in the database, wherein each of the selected alias and the selected personal identification entry is previously selected by the account-holder (See Pare figures 2, column 5, line 65-column 9, line 65);
- an interface portion in communication with the ~~card~~account controller operating portion, the interface portion effecting a transaction for the account-holder by the account-holder entering the selected alias and an entered personal identification entry into the interface portion, the interface portion communicating the selected alias and entered personal identification entry to the ~~card~~account controller operating portion (See Pare figures 2, column 5, line 65-column 9, line 65);
- wherein the ~~card~~account controller operating portion searches the database for the selected alias and the selected personal identification entry that is linked to the selected alias, the ~~card~~account controller operating portion authenticating the transaction and communicating such authentication to the interface portion if the entered personal identification entry entered by the account-holder matches the selected personal identification entry found through the database search (See Pare figures 2, column 5, line 65-column 9, line 65); and

Art Unit: 3621

- the interface portion completing the transaction for the account number if the transaction is authenticated (See Pare figures 2, column 5, line 65-column 9, line 65).

21. As per claim 2, Pare teaches the system of claim 1, wherein the account number is a credit card number, and the interface portion completing the transaction if the transaction is authenticated includes charging the credit card number (See Pare column 8, lines 41-64).

22. As per claim 3, Pare teaches the system of claim 1, wherein the transaction is completed over the Internet (See Pare column 8, lines 43-47).

23. As per claim 4, Pare teaches the system of claim 3, wherein the interface portion is a merchant (See Pare figures 24 and 25, column 8, lines 41-64).

24. As per claim 5, Pare teaches the system of claim 1, wherein the account is selected from the group consisting of a credit card account, a mutual funds account, a money market account, a margin account, a bank account, a line of credit account, a sweeps card account, a stock account, and an information account (See Pare column 5, lines 39-44, column 6, lines 18-24, and column 8, lines 41-64).

25. As per claim 6, Pare teaches the system of claim 1, wherein the interface portion is an automated teller machine (See Pare figure 1, column 11, lines 28-65, and column 16, lines 331-44).

26. As per claim 7, Pare teaches the system of claim 1, wherein the selected personal identification entry is a personal identification number (PIN) (See Pare column 6, lines 3-9).

Art Unit: 3621

27. As per claim 8, Pare teaches the system of claim 1, wherein the selected alias includes at least one of numbers, alphanumeric, names, phrases, fingerprint recognition, gene identification, DNA identification, biometrics, retina identification, and voice recognition (See Pare column 6, lines 3-9 and column 12, lines 16-52).

28. As per claim 9, Pare teaches the system of claim 1, wherein the selected personal identification entry includes at least one of numbers, alphanumeric, names, phrases, fingerprint recognition, gene identification, DNA identification, biometrics, retina identification, and voice recognition (See Pare column 6, lines 3-9 and column 12, lines 16-52).

29. As per claim 10, Pare teaches the system of claim 1, further including the ~~card~~account controller operating portion charging a fee in connection with performing the transaction for the account number if the transaction is authenticated (See Pare column 67, lines 29-34).

30. As per claim 11, Pare teaches the system of claim 1, wherein the interface portion is a merchant portion, and the merchant portion prompting the account-holder for entry of a further selection subsequent to the account-holder entering the selected alias and entered personal identification entry; and wherein the merchant portion completing the transaction based on the further selection (See Pare column 5, lines 39-44 and column 6, lines 14-47).

31. As per claim 12, Pare teaches the system of claim 11, wherein the merchant portion prompts the account-holder for entry of a further selection using a selection menu, and wherein the further selection determines which one of a plurality of possible payment methods is used (See Pare column 5, lines 39-44, column 8, lines 23-64).

Art Unit: 3621

32. As per claim 13, Pare teaches the system of claim 12, wherein the plurality of possible payment methods includes a credit payment method and a debit payment method (See Pare column 6, lines 41-47 and column 8, lines 41-64).

33. As per claim 17, Pare teaches the system of claim 1, wherein the ~~card~~account controller operating portion verifies the account-holder identification parameters of a computer of the account-holder, the computer used in the transaction (See Pare figure 17, column 62, lines 12-17).

34. As per claim 18, Pare teaches the system of claim 1, wherein the interface portion includes a keypad, the selected alias and the entered personal identification entry are entered using the keypad (See Pare column 11, lines 45-49).

35. As per claim 31, Pare teaches the system of claim 1, wherein at least one of the selected alias and the entered personal identification entry is based on human characteristic recognition (See Pare column 6, lines 3-9 and column 12, lines 16-52).

36. As per claim 32, Pare teaches the system of claim 31, wherein the interface portion includes at least one of a fingerprint recognizer, gene identifier, DNA identifier, biometrics recognizer, retina identifier, and voice recognizer (See Pare column 6, lines 3-9 and column 12, lines 16-52).

37. As per claims 33-35, Pare teaches all the limitations of claim 1, further;
Pare discloses,

That the account-holder enters a specialty personal identification entry using the interface portion, the specialty personal identification entry effecting an operation on the account (See Pare column 6, line 59- column 7, line 27 and column 40, lines 1-8).

Art Unit: 3621

that the entry of the specialty personal identification entry performs an operation selected from the group deactivating the account and activating the account (See Pare column 6, line 59- column 7, line 27 and column 40, lines 1-8).

that the account is a funds account and the entry of the specialty personal identification entry adjusts the available balance of the funds account (See Pare column 6, line 59- column 7, line 27 and column 40, lines 1-8).

38. As per claim 36, Pare teaches the system of claim 1, further;

- the account is one of a plurality of possible accounts (See Pare column 6, lines 3-24 and column 36, lines 60-68); and

the interface portion accepting entry of the entered personal identification entry from the account-holder includes accepting entry of one of a plurality of possible entered personal identification entries, the one of a plurality of possible entered personal identification entries determining which of the plurality of possible accounts is used in the transaction (See Pare column 6, lines 3-24 and column 36, lines 60-68).

39. As per claim 37, Pare teaches the system of claim 36, further including the interface portion providing the account-holder with feedback information regarding which of the plurality of possible accounts was used in the transaction (See Pare column 7, lines 15-27, column 11, lines 47-50, and column 12, lines 53-65).

40. As per claim 39, Pare clearly teaches the system as described in the claim 39 and the same rejection is applied to claim 39 as it has been applied to reject claims 1, 33, and 34.

Art Unit: 3621

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,838,812 to David Ferrin Pare et al in view of U.S. Patent Application Publication No. US 2002/0023108 to Neil Dawsani et al.

43. As per claim 14, Pare teaches the system of claim 1, further;

What is clearly thought by Pare is the selected personal identification entry is one of a plurality of possible selected personal identification entries (See Pare figures 2, column 5, line 65-column 9, line 65),

What is not explicitly disclosed by Pare, is the rotation among different selected personal identifiers as they are requested at the point of contact with the system.

However, Dawsani clearly teaches the steps of rotation among different passwords or user ids and prompting the user to enter such information into the system for verification.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made for further security and enhanced access control to add additional layer of security provided by Dawsani teachings to that of the Pare.

44. Claims 19-25 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,838,812 to David Ferrin Pare et al.

Art Unit: 3621

45. As per claim 19, Pare teaches all the limitations of claim 1, what is not explicitly disclosed by Pare is the account-holder is a first business entity and the cardaccount controller operating portion is a second business entity.

However, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to consider each user of the system as a business entity. There is no difference being an individual or a business entity to use a computerized system. In case of the business entity, the business entity would be able to track the users of the system based on their individual personal identity selection, which again would not be any different than the personal use of such system.

46. As per claims 20 and 21, Pare teaches all the limitations of claim 1, what is not explicitly disclosed by Pare is wherein the selected personal identification entry is an authorized signature, and the interface portion includes a digital signature pad, the account-holder signing a signed signature on a digital signature pad; and wherein the cardaccount controller operating portion compares the authorized signature with the signed signature.

The examiner takes Official Notice that using signatures as identifying information either electronically or manually is old and well established practice in the financial and security business for establishing identity of the submitter of such signature or authenticating such signature against a captured and stored signature. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such authentication system to the Pare's teaching for additional security.

47. As per claims 22-25, Pare teaches all the limitations of claim 1,

The examiner takes Official Notice that using at least one communications method of an Internet transmission, a telephone communication, a person-to-person communication, a cellular phone system communication, a personal communications service communication and by mail to

Art Unit: 3621

request a change of passwords or user ids in a regular bases such as changing the personal identification entry from a prior personal identification entry, as well as that the prior personal identification entry becomes invalid once it has been used a predetermined number of times, it is also well known that the number of times could be determined by the user, is old and well established practice in the security and authentication systems for better protection of users from unauthorized access. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such update and changes of passwords or user ids for further enhancements of authentication system to the Pare's teaching for additional security.

48. As per claims 40-42, Pare teaches all the limitations of claim 1, further;

Pare teaches that,

- the entered personal identification entry includes a first partial personal identification entry and a second partial personal identification entry, and the account-holder includes a first person and a second person; and
- the interface portion accepts entry of the first partial personal identification entry by the first person; and
- the interface portion accepts entry of the second partial personal identification entry by the second person; and
- wherein the first partial personal identification entry and a second partial personal identification entry collectively form the entered personal identification entry.
- wherein the interface portion determines an elapsed time period between accepting entry of the first partial personal identification entry and accepting entry of the second partial personal identification entry; and the interface portion nulls the second partial personal identification entry if the elapsed time period exceeds a predetermined time period.
- wherein the interface portion accepts entry of the predetermined time period from the first person.

Art Unit: 3621

The examiner takes Official Notice that use of partial passwords of multiple persons and using the combination of such passwords as a whole, and using a elapsed time limit for such entry of multiple pieces into the system, as well as setting such time limit is well established in secure access and authentication systems. For example the use of two keys for opening a safe deposit box at the bank would be the most mechanical version of this, as well as entry of at least two launch codes or should say pass codes by the air force personnel for initiating a launch of nuclear missile and so on. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such multiplicity of password requirement. Even the use of a user ID and password by itself is what the applicant has claimed in the above claim. First portion is the user id and the second portion is the pass code which the combination of the two authenticates the user.

49. Claims 26-28 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,838,812 to David Ferrin Pare et al. in view of U.S. Patent No. 6,016,476 to Stephen H. Maes et al.

50. As per claims 26-28, Pare teaches all the limitations of claim 1, what is not explicitly disclosed by Pare is the system further includes a personal digital assistant, the account-holder entering the selected alias and the entered personal identification entry (information) into the personal digital assistant, the personal digital assistant then communicating the selected alias and the entered personal identification entry to the interface portion for authenticating the transaction (See Maes abstract, column 2, lines 32-49, column 3, lines 20-22 and column 12, lines 5-29).

wherein the interface portion includes a processing system of a cashier (See Maes abstract, column 2, lines 32-49, column 3, lines 20-22 and column 12, lines 5-29).

Art Unit: 3621

wherein the processing system of the cashier electronically transmits digital receipt information to the personal digital assistant (See Maes abstract, column 2, lines 32-49, column 3, lines 20-22 and column 12, lines 5-29).

However, Maes clearly discloses the above limitations that Pare is not explicit on.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Pare and Maes to accomplish portability of the process for accomplishment of

51. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,838,812 to David Ferrin Pare et al. in view of U.S. Patent publication No. 2003/0037262 A1 to Robert D. Hillhouse.

52. As per claims 29 and 30, Pare teaches all the limitations of claim 1, further; Hillhouse clearly teaches the selected alias and personal identification entry includes:

- a static portion, the static portion being a portion of the selected alias that is not changed (See Hillhouse paragraph [0034], [0035], and [0050]); and
- a dynamic portion, the dynamic portion being a portion of the selected alias that is changed, the account-holder changing the dynamic portion of the selected alias while not changing the static portion of the selected alias using the interface portion (See Hillhouse paragraph [0034], [0035], and [0050]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Pare and Hillhouse to produce a further enhanced security and authentication system that is less vulnerable to intrusion attacks.

53. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the

Art Unit: 3621

individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Art Unit: 3621

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner



September 19, 2005